

**REMARKS AND STATEMENT OF EDGAR W. AVERILL, JR.**

**RE AT LEAST ONE ERROR**

As set forth in the Reporter's Transcript of Proceedings of Monday, November 26, 2001, in the case of Alex Bellehumeur, Plaintiff, vs. Carl Lekavich, et al., Defendants, CV01-138-RSWL, the subject patent No. 5,597,161, was held unenforceable as set forth on pages 5 and 6 of the transcript (attached hereto as Exhibit 1). This states in part:

"This Court finds that Bellehumeur and his co-inventors, however, assigned the rights to the parent patent and the pending continuation applications. Bellehumeur only then filed a Terminal Disclaimer. The Court finds that Bellehumeur had no interest or rights in the '161 pending applications to so disclaim or limit its terms. Similarly, Bellehumeur did not have common ownership in the parent patent, and the pending continuation patent, as required by the Terminal Disclaimer for the '161 patent to be enforceable.

"Because the requirement is the common ownership of the '161 and '410 patents was not met, the '161 patent is not enforceable."

The purpose of the present reissue application is to request a decision by the Patent Office as to the effect of the mistake in the Terminal Disclaimer, which erroneously indicated that Alex R. Bellehumeur was a 100% owner of application No. 08/590,870 which matured into

U.S. Patent No. 5,597,161. A copy of the Terminal Disclaimer dated June 5, 1996, is attachment 17c.

It was the undersigned attorney who signed the Terminal Disclaimer on behalf of Alex R. Bellehumeur. In fact, the parent patent No. 5,275,410 had been assigned by the three applicants effective January 1, 1996. The existence of this assignment was unknown to the undersigned at the date of his signing of the Terminal Disclaimer on June 5, 1996. The assignment by the applicants to Roller Hockey International, effective January 1, 1996, signed February 8, 1996, and recorded April 3, 1996, was not prepared by the undersigned, but instead, by the firm of Roth and Goldman. This firm was recommended by the undersigned to handle the foreign patent filings for Bellehumeur, et al., and apparently prepared this assignment in conjunction with the filing of foreign patent applications. A one-sheet summary of the applications and assignments re the '410 and '161 patents is attached hereto as Exhibit 2.

Had the undersigned been aware of this assignment, the undersigned would have placed the name of Roller Hockey International, a California limited partnership, in the ownership blank. The undersigned was also the attorney for intellectual property matters for Roller Hockey International, a California limited partnership.

It is submitted that the undersigned's mistake in the June 5, 1996, Terminal Disclaimer does not rise to the level of a mistake which would cause the patent to be invalid or unenforceable. The existence of a Terminal Disclaimer is printed on the '161 patent face sheet, and thus, there is no lack of notice to the public of the existence of a Terminal Disclaimer.

The parent patent '410 and the application which matured into the '161 patent were commonly owned by Roller Hockey International, a California limited partnership on June 5, 1996, the date of the signing of the Terminal Disclaimer.

By way of assignments of the parent '410 patent, both patents after the '161 issued, have been commonly owned. Thus, there is no motivation or reason for the undersigned to provide inaccurate information in the Terminal Disclaimer deliberately, or with any intent to deceive.

The Federal Circuit recognized the realities of patent practice in Northern Telecom Inc. v. Datapoint Corp. (Fed.Cir.1990) 15 USPQ2d 1321 at page 1327 as follows:

“[5] Intent to deceive should be determined in light of the realities of patent practice, and not as a matter of strict liability whatever the nature of the action before the PTO. *Accord Pfizer, Inc. v. International Rectifier Corp.*, 538 F. 2d 180, 186, 190 USPQ 273 , 278 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 [ 192 USPQ 543 ] (1977). "A patentee's oversights are easily magnified out of proportion by one accused of infringement...." *Id.* at 196, 190 USPQ at 286 . Given the ease with which a relatively routine act of patent prosecution can be portrayed as intended to mislead or deceive, clear and convincing evidence of conduct sufficient to support an inference of culpable intent is required.”

It is requested that the examiner allow the reissuance of this patent with a conclusion that the mistake was an inadvertent one, was and is correctable and that the validity and

enforceability of the patent are not affected by the mistake.

Respectfully submitted,



EDGAR W. AVERILL, JR.

Reg. #24,752

Attorney for Applicant

Law Offices of Averill & Varn  
8244 Painter Ave.  
Whittier, CA 90602  
562/698-8039

**ATTACHMENT 17d**  
**LITIGATION STATUS**

U.S. Patent No. 5,597,161 is involved in 4 patent infringement actions as follows:

Bellehumeur v. Lekavich

Bellehumeur v. Skate America, Pro Puck

Bellehumeur v. Tsunami

Bellehumeur v. Bonnett

A status conference is set in the Bellehumeur v. Skate America, Pro Puck matter on February 11, 2002, in New York City. The Bonnett matter proceeds to trial on May 7, 2002. Trial in the Tsunami matter is set for May 28, 2002, and trial in the Lekavich matter will take place on June 4, 2002.

A copy of a motion for summary judgment which was granted in Bellehumeur v. Lekavich is attached, as well as the responses thereto. It is believed that this motion and its response will be useful to the examiner to provide background as to the basis for which the '161 patent was found to be unenforceable and which gave rise to the present reissue application.

## EXHIBIT A

At least one error upon which reissue is based is described as follows:

An erroneous Terminal Disclaimer was filed in the application which indicated that Alex R. Bellehumeur owned a 100% interest in the application. In fact, the application was owned by Roller Hockey International, a California limited partnership. The Court found that Mr. Bellehumeur had no interest or rights in the '161 pending applications to so disclaim or limit its terms. Similarly, Mr. Bellehumeur did not have common ownership in the parent patent and the pending continuation patent as required by the Terminal Disclaimer for the '161 patent to be enforceable.

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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

BEFORE: HONORABLE RONALD S. W. LEW, JUDGE PRESIDING

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ALEX BELLEHUMEUR,

PLAINTIFF,

-VS-

CV 01-138-RSWL

CARL LEKAVICH, ET AL.,

DEFENDANTS.

-----X

REPORTER'S TRANSCRIPT OF PROCEEDINGS

MONDAY, NOVEMBER 26, 2001

LOS ANGELES, CALIFORNIA

ROGER D. MAY, CSR

312 N. SPRING STREET #406

LOS ANGELES, CA 90012

1 APPEARANCES:

2  
3 FOR THE PLAINTIFF(S):

4  
5 OFFICES OF JOSEPH R. DONAHUE & ASSOCIATES

6 BY: JOSEPH R. DONAHUE, ESQ.

7 19900 MACARTHUR BOULEVARD, SUITE 1150

8 IRVINE, CA 92612  
9

10  
11 FOR THE DEFENDANT(S):

12  
13 EMMA FORREST, ESQ.  
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I-N-D-E-X

HEARING:

DEFENDANT CARL LEKAVICH AND IDEAL DESIGN SPORTS,  
INC.'S MOTION FOR SUMMARY ADJUDICATION, AND MOTION FOR  
AWARD OF ATTORNEY'S FEES

\* \* \*

1 MONDAY, NOVEMBER 26, 2001; LOS ANGELES, CALIFORNIA

2 -- 9:00 A.M. --

3 THE CLERK: CALLING ITEM NO. 5, CIVIL 01-138-RSWL,  
4 ALEX BELLEHUMEUR VERSUS CARL LEKAVICH, ET AL.

5 COUNSEL, PLEASE STATE YOUR APPEARANCES.

6 MR. DONAHUE: GOOD MORNING, YOUR HONOR. JOE DONAHUE  
7 FOR THE PLAINTIFF AND RESPONDING PARTY.

8 MS. FORREST: GOOD MORNING, YOUR HONOR. EMMA FORREST  
9 FOR DEFENDANT.

10 THE COURT: WHY WERE YOU LATE?

11 MS. FORREST: THREE AND A HALF HOURS FROM SAN DIEGO,  
12 YOUR HONOR.

13 THE COURT: YOU SHOULD HAVE LEFT FIVE HOURS AGO.

14 MS. FORREST: I SHOULD HAVE.

15 THE COURT: NO EXCUSE.

16 MS. FORREST: OKAY.

17 THE COURT: I HAD LAWYERS TELL ME THEY WERE LATE  
18 BECAUSE OF THE INCLEMENT WEATHER AND THE FLIGHT SCHEDULES AND I  
19 WAS SITTING IN SACRAMENTO AND THE LAWYER'S COMING FROM TEXAS.  
20 I WAS THERE AT NINE O'CLOCK. THEY WEREN'T. NO EXCUSE. RIGHT?

21 MS. FORREST: RIGHT.

22 THE COURT: ALL RIGHT. THIS IS DEFENDANT CARL  
23 LEKAVICH AND IDEAL DESIGN SPORTS, INC.'S MOTION FOR SUMMARY  
24 ADJUDICATION AND A MOTION FOR AWARD OF ATTORNEY'S FEES. I READ  
25 THE MOVING PAPERS AND THE OPPOSITION. FURTHER ARGUMENT?

1 MS. FORREST: I REST ON THE MOVING PAPERS, YOUR HONOR,  
2 UNLESS --

3 THE COURT: I HAVE QUESTIONS?

4 MS. FORREST: COUNSEL HAS SOMETHING FURTHER TO ADD.

5 THE COURT: ALL RIGHT. ANY FURTHER OPPOSITION?

6 MR. DONAHUE: NO, YOUR HONOR.

7 THE COURT: ALL RIGHT. THREE AND A HALF HOURS TO SAY  
8 "SUBMITTED." VERY GOOD.

9 HAVING CONSIDERED ALL THE PAPERS SUBMITTED ON BEHALF OF  
10 THE MOTION AND IN OPPOSITION, I MAKE THE FOLLOWING RULING:

11 AS TO DEFENDANTS' MOTION FOR SUMMARY JUDGMENT, THE  
12 CLAIMS EXAMINER REJECTED PLAINTIFF'S CONTINUATION PATENT  
13 APPLICATIONS NUMEROUS TIMES ON THE GROUNDS OF DOUBLE PATENTING.  
14 THE CLAIMS EXAMINER MADE CLEAR THAT THE CONTINUATION PATENT  
15 APPLICATION FOR THE '161 PATENT WOULD ONLY BE ISSUED IF THE  
16 PLAINTIFF FILED AN APPROPRIATE TERMINAL DISCLAIMER, WHICH WOULD  
17 OVERCOME THE REJECTION ON DOUBLE PATENTING GROUNDS PROVIDED THE  
18 CONFLICTING PARENT PATENT WAS SHOWN TO BE COMMONLY OWNED WITH  
19 THE PENDING APPLICATION.

20 THIS COURT FINDS THAT THE BELLEHUMEUR AND HIS  
21 CO-INVENTORS, HOWEVER, ASSIGNED THE RIGHTS TO THE PARENT PATENT  
22 AND THE PENDING CONTINUATION APPLICATIONS. BELLEHUMEUR ONLY  
23 THEN FILED A TERMINAL DISCLAIMER. THE COURT FINDS THAT  
24 BELLEHUMEUR HAD NO INTERESTS OR RIGHTS IN THE '161 PENDING  
25 APPLICATIONS TO SO DISCLAIM OR LIMIT ITS TERMS. SIMILARLY,

1 BELLEHUMEUR DID NOT HAVE COMMON OWNERSHIP IN THE PARENT PATENT  
2 AND THE PENDING CONTINUATION PATENT AS REQUIRED BY THE TERMINAL  
3 DISCLAIMER FOR THE '161 PATENT TO BE ENFORCEABLE.

4 BECAUSE THE REQUIREMENT IS THE COMMON OWNERSHIP OF THE  
5 '161 AND '410 PATENTS WAS NOT MET, THE '161 PATENT IS NOT  
6 ENFORCEABLE.

7 THE COURT, THEREFORE, GRANTS SUMMARY JUDGMENT ON THIS  
8 BASIS. THE COURT FINDS THAT DEFENDANTS ARE ENTITLED TO SUMMARY  
9 JUDGMENT ON THE GROUNDS JUST STATED, BUT NOT ON THE BASIS OF  
10 THE FRAUDULENT PROCUREMENT OF PATENT OR INEQUITABLE CONDUCT.

11 AS TO THE DEFENDANTS' MOTION FOR ATTORNEY'S FEES, THIS  
12 COURT MAY AWARD ATTORNEY'S FEES TO THE PREVAILING PARTY IN THE  
13 PATENT INFRINGEMENT CASE WHERE THE CASE IS EXCEPTIONAL.

14 BECAUSE THERE IS A GENUINE ISSUE OF MATERIAL FACT AS TO  
15 WHETHER PLAINTIFF AND HIS ATTORNEY HAD THE REQUISITE INTENT TO  
16 DECEIVE THE PATENT AND TRADEMARK OFFICE, THE COURT CANNOT  
17 DETERMINE AS A MATTER OF LAW PLAINTIFF FRAUDULENTLY PROCURED  
18 THE '161 PATENT.

19 I DENY THE DEFENDANTS' MOTION FOR ATTORNEY'S FEES SINCE  
20 THIS COURT HAS NOT FOUND THIS TO BE AN EXCEPTIONAL CASE  
21 INVOLVING PLAINTIFF'S INEQUITABLE CONDUCT.

22 YOU HAVE SUBMITTED PROPOSED FINDINGS OF FACT AND  
23 CONCLUSIONS OF LAW WHICH I WILL SIGN WITH MODIFICATIONS, AS  
24 WELL AS A PROPOSED ORDER WHICH I WILL SIGN WITH MODIFICATIONS.  
25 I SUPPOSE WE WILL NEED A JUDGMENT; CORRECT?

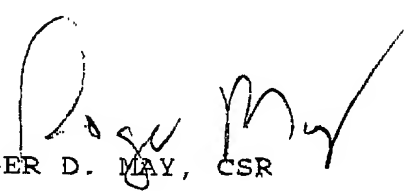
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MS. FORREST: CORRECT, YOUR HONOR.

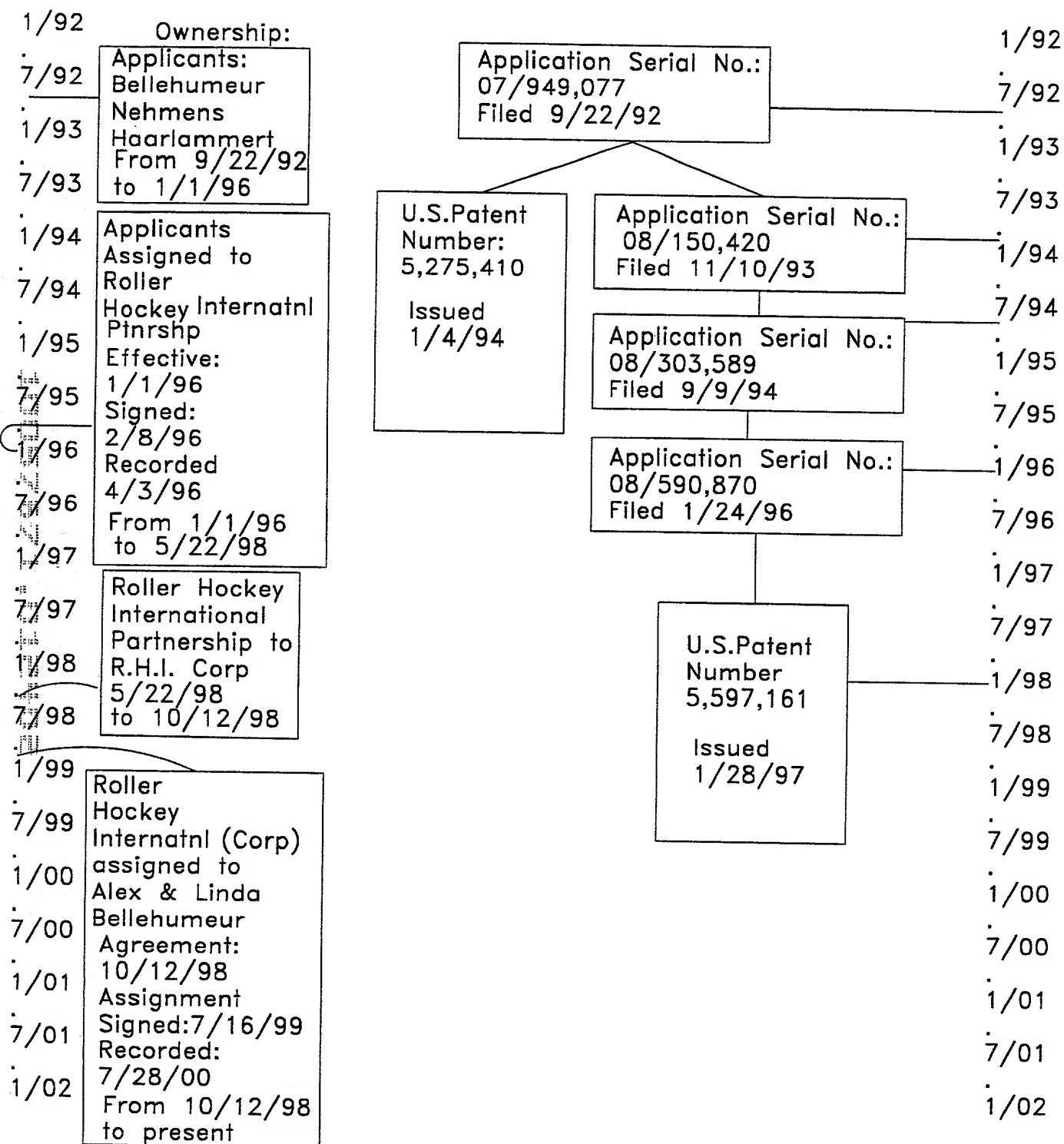
THE COURT: SUBMIT THE JUDGMENT. THAT'S THE ORDER.

MS. FORREST: THANK YOU, YOUR HONOR.

(I HEREBY CERTIFY THAT THE FOREGOING IS AN ACCURATE  
TRANSCRIPTION OF MY STENOGRAPHIC NOTES IN THE  
ABOVE-REFERENCED MATTER)

  
ROGER D. MAY, CSR

DATE: 11/6/01



**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

In re Application of: Alex R. Bellehumeur  
Application No. 08/590,870  
Filed: 1/24/96  
For: Puck for Use on a Non-Ice Surface

The owner, Alex R. Bellehumeur of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 5,275,410. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

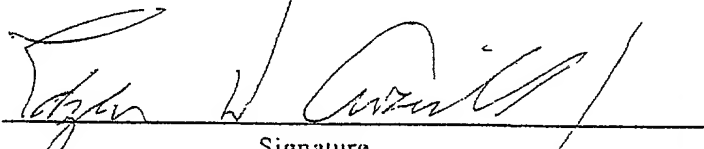
☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney of record.

June 5, 1996

Date

  
Signature

Edgar W. Averill, Jr.

Typed or printed name

☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

☐ PTO suggested wording for terminal disclaimer was

☒ unchanged. ☐ changed (if changed, an explanation should be supplied).

Burden Hour Statement: This form is estimated to take 2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time required to complete this form should be sent to the Office of Assistance Quality and Enhancement Division, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0031), Washington, DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner of Patents and Trademarks, Washington, DC 20231.

Attachment 17(c)